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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,188	03/10/2004	Erik Haraldsted	APFX.P0001	5293
7590	11/29/2005			
Vincent Tassinari 125 Grand Ave #201 Long Beach, CA 90803-2700			EXAMINER REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



### **DETAILED ACTION**

This office action is in response to Applicant's amendment filed 10/17/2005.

#### ***Status of Claims***

- [1] Claims 1-33 are pending.

#### ***Election/Restrictions***

- [2] This application contains claims 4-8, 10, 12-13, 18-21, and 24-30 drawn to an invention nonelected without traverse in Paper No. 3/18/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Rejections - 35 USC § 102***

- [3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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[4] Claims 1-3, 9, 11, 14-17, 22-23, and 31-33 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Rivaud, US- 4,590,775, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Rivaud is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Rivaud teaches of a pressure earring, comprising:

a support having a first support end (1), a second support end (to the right of 2), and a base (2) positioned between the first support end (1) and the second support end (to the right of 2);

an ornament (7) having a first piece (7) coupled to the first support end (1) and a second piece (7) coupled to the second support end (to the right of 2) to define a gap (between 9) between the first piece (7) and the second piece (7) ;

a pad (5); and

means for coupling the pad to the support (8).

Re: Claim 2, where the means for coupling the pad (5) to the support includes a post attached to the support (3).

Re: Claim 3, where the post (3) is attached to the support (2) to define between the post (3) and the support (2) both an opening (beginning of 2) and a slot (inside of 2), where the opening (beginning of 2) leads to the slot (inside of 2).

Re: Claim 9, further comprising:

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means for stabilizing the pad to the support (5 against 6 in Fig. 4).

Re: Claim 11, where the ornament (7) conveys an image (arrow 7).

Re: Claim 14, where the pad (5) defines a pad shape that is at least one of cylindrical, tubular, toroidal, rectangular, spherical (5), gum-dropped, and mushroom capped.

Re: Claim 15, where the pad (5) is marked by the ability to return towards an original position, as after having been compressed (Fig. 4 to Fig. 1).

Re: Claim 16, where the pad is resilient (5 in Fig. 4).

Re: Claim 17, where the pad includes a material from a group of materials consisting of silicone, rubber, foam, cork, sponge, polyurethane, polystyrene, polyolefin, fluoropolymer, vinyl, naturally occurring substance, and gel that is configured to be contained in a gel pack (column 2, line 3, "The earring is constituted...of any appropriate material").

As for Claim 22, Rivaud teaches of a jewelry structure comprising:

a support having a first support end (1), a second support end (to the right of 2), and a base (2) positioned between the first support end (1) and the second support end (to the right of 2);

an ornament (7) having a first piece (7) coupled to the first support end (1) and a second piece (7) coupled to the second support end (to the right of 2) to define a gap (between 9) between the first piece (7) and the second piece (7) ;

means for coupling the pad to the support (8).

Re: Claim 23, where the means for coupling the pad to the support includes at least one of a post (3) attached to the support (2) and adhesive "adapted to be positioned between the pad and the support" (Note that it has been held that the recitation that an element is "adapted to"

perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Thus, in the instant case, adhesive could be “adapted to” be positioned between the pad and the support).

As for Claim 31, Rivaud teaches of a nonpiercing jewelry comprising:

a support having a first support end (1), a second support end (to the right of 2), and a base (2) positioned between the first support end (1) and the second support end (to the right of 2);

an ornament (7) having a first piece (7) coupled to the first support end (1) and a second piece (7) coupled to the second support end (to the right of 2) to define a gap (between 9) between the first piece (7) and the second piece (7) ;

a post (3) attached to the support (2); and

a pad (5) “adapted to be” coupled to the post (5 onto 3).

Re: Claim 32, where the post (3) is attached to the support (2) to define between the post (3) and the support (2) both an opening (beginning of 2) and a slot (inside of 2), where the opening (beginning of 2) leads to the slot (inside of 2).

Re: Claim 33, where the support (2) includes a support surface (1) positioned adjacent to the slot (inside of 1).

### ***Response to Arguments***

[5] Applicant's arguments filed 10/17/2005 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. To begin, in claim 1, the applicant states that said claim recites of a pad. Applicant continues that said pad is a cushionlike mass of soft material; and that the pad may be compressed and uncompressed, as stated in the specification.

In response to Applicant's above argument, the applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these features of the pad are found as examples of embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. The only weight with regard to the term, therefore, is the term, "pad" itself. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and thus in the instant case, numeral 5 from Rivaud, can and is indeed considered a pad, as one can easily see from its role in Fig. 4 resting against 6.

In response to Applicant's argument with regard to claim 2, that Rivaud does not include certain features of Applicant's invention, the limitations on which the applicant relies ("does not teach end 5 as being an element separate and apart from 3) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

With regard to amended claim 3 (see above claim rejections), it is once again pertinent to point out that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974) and even with said amendment to the instant claim, Rivaud still anticipates.

In Claim 9, means-plus-function limitations are met where an examiner identifies a specific element(s) in a prior art reference which is capable of performing the function described

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in the means-plus-function limitation, *In re Lundberg*, 244 F.2d 543, 113 USPQ 530 (CCPA 1957). It is the language itself of the claims, which must particularly point out and distinctly claim the subject matter which the applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of a detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim.

With regard to applicant's argument concerning claim 15, the only thing that the instant claim requires is that said pad is marked by the ability to return towards an original position. So thus, the pad from Fig. 4 is marked by the ability (i.e. is capable), to return towards an original position (i.e. Fig. 1.); as such terminology is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With regard to Claim 16, applicant states that the pad as shown by Rivaud is not resilient. Examiner disagrees.

With regard to Claim 17, Applicant states that that disclosed by Rivaud, "...of any appropriate material" is not anticipatory toward that currently stated in Claim 17. Examiner disagrees as Rivaud teaches that any appropriate material can constitute the earring, appropriate material constituting to one familiar in the art of jewelry varying materials including those stated in said claim.

With regard to applicant's argument concerning claim 22, see Fig. 1, generally shown by number 8, which shows pad, 5, being coupled to said support, 1, via 3 and 2.



With regard to Claims 22 and 23, it is also important to point out that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In claim 22, it is stated that “a jewelry structure (Fig. 1) adapted to be assembled with a pad (5) to form a nonpiercing jewelry (Fig. 1)”...and during the assembling process a pad, 5, is indeed assembled to said jewelry structure and in the case of Claim 23, via a post 3. Just as, in turn, the jewelry structure is adapted to be able, has the ability to have adhesive positioned between the pad and the support.

With regard to the arguments concerning the latter claims, 31-32, said terminology in said claims has been aforementioned above; and lastly, with regard to claim 33, Rivaud does indeed teach of a slot, that being inside of 1, or more specifically 2 in Fig. 1.

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*Conclusion*

[6] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

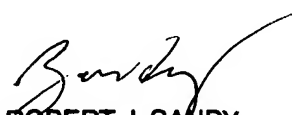
[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
**ROBERT J. SANDY**  
**PRIMARY EXAMINER**